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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,824	10/13/2000	Philipp Muller	WAS 0394 PUS	9858

22045 7590 09/05/2003

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EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/05/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

1. The Applicants' response to election of species requirement filed on June 24, 2003 was received.
2. Examiner has reconsidered any election of species requirement regarding the instant application and has decided to give an action on the merits for all species.
3. It was brought to Mr. William G. Conger's attention on August 21, 2003 that the first page of PTO-1449 form filed on November 13, 2003 is missing. Examiner was told that a complete copy of the instant PTO-1449 will be mailed to the Office again. Therefore, at present, there will be no corresponding signed PTO-1449 to be sent to Applicants.

Claim Objections

4. Claim 6 is objected to because of the following informalities:

Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation of Claim 6 is exactly the same as that of Claim 4.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiki (US 5 536 803) in view of Pesch (US 2001/0011117).

With respect to Claims 1-2, Fujiki discloses an adhesive silicone composition comprising A) a diorganopolysiloxane, B) an organohydrogenpolysiloxane, C) an organohydrogensiloxane of formula (3) (hereinafter Component C1) having aromatic substituents and D) a platinum catalyst (col. 2, line 8 to col. 3, line 26 and col. 13, lines 47-56). Component B) is optional (col. 4, lines 28-43). Component C1) Component C1) can be exemplified as the compounds recited in the structure in the bottom of col. 7 - col. 8 and the first structure in col. 9-col. 10. Note that Z in formula (3) can be a divalent radical having 6 to 8 carbon atoms (col. 8, lines 1-12). Therefore, the ethylene radicals in the aforementioned two structures can be replaced by hexanylene, heptanylene or octylene radicals. Component C1) can have a viscosity of 2 to 1000 centipoise at 25°C (col. 8, lines 32-36).

When the instant claims encompass the embodiment wherein the divalent R⁵ being a C₉ to C₂₀, optionally substituted, hydrocarbon radical, Fujiki obviously discloses Applicants' organohydrogenpolysiloxane because of the following reasons: Fujiki's Z in formula (3) can be any divalent radical (col. 2, lines 40-50) which can be exemplified as C₆ to C₈ (col. 8, lines 1-

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12). As such, one of ordinary skill in the art would have used Component C1) with Z being C₉ to C₂₀ without undue experimentation. Furthermore, as mentioned previously, Fujiki's Component C1) is exemplified as the compounds recited in the structure in the bottom of col. 7 - col. 8 and the first structure in col. 9-col. 10 wherein Z is a divalent radical having 6 to 8 carbon atoms.

Noted that the instant compounds have similar structures as compared to Applicants' organohydrogenpolysiloxane wherein R⁵ being a C₉ to C₂₀, optionally substituted, hydrocarbon radical. Also, Fujiki's disclosure is in the same field as that of Applicant's endeavor

"An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties" In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979) (see MPEP 2144.09 and MPEP 2144.08, II. A. 4(c))

The difference between Fujiki and the present invention is the requirement of an organosilicon compound having epoxy groups and hydrolysable groups.

Fujiki teaches that the adhesive silicone composition can further contain other optional components (col. 13, lines 63-65). Pesch teaches the use of an alkoxysilane containing epoxy groups in an adhesion composition containing addition crosslinking silicone rubber mixture ([004]-0010] and [0037]). The motivation of using the alkoxysilane containing epoxy groups is to afford an adhesion composition which, when applied to substrates and crosslinked, have good adhesion to the substrates ([0004]). In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the alkoxysilane containing epoxy groups in Fujiki's composition. Especially, Pesch's disclosure is in the same field as that of the Fujiki's endeavor

With respect to Claims 3-10, Fujiki further teaches a process for bonding the composition to a substrate by heating at a temperature of about 60° to about 180°C (col. 15, lines 5-9 and Examples).

7. The "X" references cited in the international search report are not relied upon because of the following reason:


None of the "X" references teaches or fairly suggests the use of a component corresponding to component B) in the instant claim.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp
September 2, 2003


Kuo-Liang Peng
Art Unit 1712

Office Action Summary

Application No.

09/687,824

Applicant(s)

MULLER ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/24/03 Election.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.